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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,250	04/03/2004	Timothy Clegg	Glegg.04	1797

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EXAMINER

VERAA, CHRISTOPHER

ART UNIT PAPER NUMBER

3611

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/817,250	<b>Applicant(s)</b> CLEGG, TIMOTHY	
	<b>Examiner</b> Christopher E. Veraa	<b>Art Unit</b> 3611	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 27 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-5 is/are allowed.
- 6) ☒ Claim(s) 6-19 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Original election was made **without** traverse to the product claims 1-21 however since claim 27 has had its dependency changed it remains with the product claims.

2. Claims 20 and 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, with claim 18 as a generic claim.

Election was made **without** traverse in the reply filed on 8/22/06. The applicant made no indication as to which claims were drawn to the different species, but the examiner indicated that claims 20 and 21 were drawn to nonelected species in the communication mailed 8/18/06.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 200, 270, and 280 (page 10). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be

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notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 36, 40, 42, 44 (fig. 2), 50 (fig. 1). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

5. The disclosure is objected to because of the following informalities:

On page 7, line 27, the element 34 is said to comprise element 35, which is said to comprise both elements 34 and 35. This description is confusing and requires revision.

On page 10, line 16, the terms SNM, SSE, and MASK are not adequately defined.

### ***Claim Objections***

6. Claims 8 and 10 are objected to because of the following informalities: Claim 8 states that the speaker section can be both "located adjacent to" and "placed adjacent to" the battery section. These appear to have the same meaning and therefore constitutes redundant and verbose wording. Claim 10 claims that the distance between the tongue attachment means and the switch on the microchip is held constant, but does so twice in language that appears to be redundant and verbose. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 6-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 recites the limitation "the microchip controller" in line 4. There is insufficient antecedent basis for this limitation in the claim.

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Claim 10 recites the limitation "the microchip" in line 2. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The terms SNM, SSE, and MASK are not adequately defined in the specification and it is therefore unclear when two 1.5V batteries are to be used.

10. Claims 18, 19 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 recites the limitation "the tongue" in line 7. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 12-14, 17-19 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clegg in view of Melton (US-5230501).

As to claim 12, Clegg teaches a business card holder that includes a sound generating device that activates when a panel of the holder is unfolded. Specifically, Clegg includes a means for emitting sound, a foldable support structure, an electronic

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microchip sound generating device, and a slide tongue mechanism. Clegg does not specifically teach inserting the device into a magazine. However, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the device of Clegg to be inserted into a magazine for advertising since the device "may be used to actively draw attention" to the advertisement (Clegg, column 2, lines 60-62). Clegg lacks an insertion flap for inserting the device into a high-speed bindery. Melton teaches an apparatus for attaching inserts into a printing press. The inserts in Melton include an insertion flap (element 50a, see figure 4).

As to claim 13, Clegg teaches that the tongue mechanism "may be connected to the sound emitting device 12 and the card portion 20 by adhesives, glues or the like." (Clegg, column 3, lines 57-60) Since tape is already employed to bond the outer pages to the inner pages, it would be obvious to one of ordinary skill to use tape as the adhesive holding the tongue mechanism to the first page.

As to claim 14, it would be obvious to one of ordinary skill in the art to mount the speaker either face up or face down because it has been held that mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 166 (CCPA 1931).

As to claim 17, It would be obvious to one of ordinary skill in the art to choose an exact number and voltage of batteries in order to meet the power requirements of the microchip sound generating device.

As to claim 18,

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13. Claims 14, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clegg in view of Melton and further in view of Fox et al (US-5245171).

As to claim 14, Fox teaches a similar sound generating device constructed in a mailing envelope. Fox teaches "The speaker may face the front or back of the envelope" (column 2, lines 23-24) and it would therefore be obvious to install the speaker facing the front or the back because mere reversal of components is routine practice in the art.

As to claim 15, Fox et al teaches using button batteries to power a microchip sound generating device in a mailer. It would be obvious to one of ordinary skill in the art to use this type of battery since they are small and compact. It would further be obvious to one of ordinary skill in the art to choose an exact number and voltage of batteries in order to meet the power requirements of the microchip sound generating device.

As to claim 16, Fox shows the speaker, the microchip, the batteries and the tongue slide mechanism as different components or modules. Fox teaches installing each of these modules on a film (13). As to the removable liner, this appears to be a component of an intermediate manufacturing step and is not a part of the final assembled product. Further, removable liners for covering adhesives before their application are notoriously well known in the art.

***Allowable Subject Matter***

14. Claim 1-5 are allowed.

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15. Claims 6-11, 18, 19 and 27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

16. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lacomis (US-6905019) teaches a magazine insert with a recording medium compartment.

Pines (US-6591523) teaches a card with electronics that plays a sound upon opening.

Krasuski et al (US-6226959) teaches a machine for inserting inserts into magazine binding.

Pace et al (US-6126201) teaches a bindable insert for mailing recording media.

Hogue et al (US-6104306) teaches a folding device that triggers an electronic device upon unfolding.

Reuben (US-5778574) teaches a folding tag that electronically plays a sound upon unfolding.

Dawson (US-5761836) teaches a card that plays a sound electronically upon unfolding.

Crowell (US-5577918) teaches a message delivery system where a recorded sound is played upon unfolding of a folded structure.

Funahashi et al (US-4286399) teaches a card that electronically illuminates upon unfolding of the card using a tongue slide mechanism.

Dickinson (US-4433783) teaches a magazine insert wherein a product sample is retained within channels formed by adhesive strips on the interior of the page.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher E. Veraa whose telephone number is 571-272-2329. The examiner can normally be reached on Monday through Friday, 7:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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